

REMARKS

Claims 1 – 46 remain in the application and stand finally rejected. Claims 1 – 4, 7, 8, 14, 17, 21, 32, 34, 39, 42, 43, 45 and 46 are amended by this proposed amendment. No new matter is added. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

Claims 1 – 27 and 32 – 46 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over published U.S. Patent Application No. 2004/0205209 to Wengrovitz et al. in view of U.S. Patent No. 7,620,408 to Ye et al. and U.S. Patent No. 6,714,793 to Carey et al. Claims 28 – 31 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over Wengrovitz et al., Ye et al. and Carey et al. in view of U.S. Patent Application No. 2005/0013421 to Chavez et al.

Applicants note that Ye et al. has a priority date less than six (6) months prior to the present application. While applicants believe it to be unnecessary to show an invention date prior to Ye et al. for the reasons set forth below, applicants reserve the right to make such a showing, if necessary.

Wengrovitz et al. and Carey et al. were relied on to teach the invention as previously claimed. The Final Office Action (Final) responds to the previous amendment, essentially asserting that Ye et al. teaches devices implementing first and second incompatible protocol devices. Thus, the Final asserts that at column 3, lines 16-41, Ye et al. teaches “multiple devices may be used for multiple communication types, including instant messaging, and where the messaging system may convert messages to a format based on the device type;” and further at lines 52-58, Ye et al. teaches “the message delivery system may contain information regarding user devices, including the ability to convert and send messages from one user to another.” Final, pages 4 and 5.

Ye et al. teaches a message delivery system 102 that “is configured to perform automatic device selection and content conversion of messages. When a message is sent to a recipient, message delivery system 102 determines devices associated with the recipient [and may convert the message] ... to a format associated with the selected one or more devices and the message is forwarded to the selected devices.” Ye et al. col. 3, lines 33 – 41. Neither Ye et al. nor any reference teaches or suggests the Ye et al. message delivery system 102 converting messages between same format devices to a different format and back.

By contrast digital telephone 140 exchanges instant messages with another telephone 160 or PC 150, the message originating from digital telephone client 140 is communicated to the PBX 110 and then to the IWU 120 using the CSTA protocol 170. At the IWU 120, the CSTA protocol is converted to a SIP/SIMPLE protocol 180, and the message is forwarded to the SIP Proxy server 130. At the SIP Proxy server 130, the recipient information (e.g. user identity) is read and consequently mapped to a specific device, and the message is routed to that device via the appropriate intermediate destination or destinations. According to the exemplary illustration of FIG. 1, if the recipient is the PC client 150 or 170, the SIP Proxy server 130 sends the IM to the intended client directly. If the recipient is telephone client 160, the SIP Proxy server 130 sends the message back to the corresponding IWU 120, where the IM application for the digital telephone is managed, the IM message is reconverted to CSTA and sent to PBX 110 and then to digital telephone 160 using CSTA 170.

Application, page 7, lines 9 – 22.

Accordingly, claims 1 – 4, 7, 8, 14, 17, 32, 34, 39, 42, 43, 45 and 46 are amended to reflect this. This is further supported by claims 7 and 41. Claim 21 is also amended to recite that the messages may be displayed on the digital telephones while the phones are on-hook. This is supported by the specification. See e.g., page 3, lines 27 – 38 (“The invention will allow these telephones to send and receive IM messages to and from other IM compatible units without needing to be off-hook.”) and page 12, lines 24 – 25 (“A telephone client that is on-line can communicate with other peers who are part of the contact list using IM without going off-hook.”). No new matter is added. Neither is any of this taught or suggested by Wengrovitz et al., Carey et al. Chavez et al. or any other reference of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 46 under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 46 under 35 U.S.C. § 103(a) and allowance of the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone No. listed below for a telephonic or personal interview to discuss any other changes.

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Respectfully submitted,

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